

REMARKS

Claims 1, 5-7, 11, 13, 15, 20, 24-26, 30, 32, 34, 39, 43-45, 49, 51, and 53 have been amended. Claims 1-9, 11-18, 20-28, 30-37, 39-47, and 49-56 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Objection to the specification:

The Office Action previously objected to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter of “computer-accessible storage medium.” Office Action at 3. In an after-final amendment indicated by the Examiner as having been entered, Applicant amended paragraph [0061] of the specification to address this objection. Accordingly, Applicant submits that the objection to the specification has been overcome.

Double Patenting Rejection:

The Office Action provisionally rejected claims 1, 11, 20, 30, 39 and 49 under the judicially- created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1, 13-15, 27-29 and 41-42 of co-pending Application No. 10/670,550 in view of Seshadri et al. (U.S. Patent 7,209,916) (hereinafter Seshadri), and over claims 1, 9-11, 19-21 and 30 of co-pending Application No. 10/670,549 in view of Seshadri. Applicant acknowledges the provisional rejection and will address it if and when it becomes non-provisional.

Section 102(e) Rejection:

The Office Action rejected claims 1-3, 11, 12, 14, 20-22, 30, 31, 33, 39-41, 49, 50 and 52 under 35 U.S.C. § 102(e) as allegedly being anticipated by Seshadri. While Applicant respectfully traverses this rejection, in order to expedite issuance of a patent, Applicant has amended various ones of the claims to increase their clarity. Applicant

submits that Seshadri fails to anticipate the amended claims for at least the following reasons.

Regarding amended claim 1, Seshadri fails to disclose a computer-implemented method comprising receiving an instant messaging operation directed to a given user, wherein said given user is not offline, wherein said instant messaging operation is associated with a specific presence state of an instant messenger, and wherein the specific presence state associated with the received instant messaging operation is determined separately from a current presence state that is currently assigned to the instant messenger; in response to receiving said instant messaging operation, determining whether the current presence state [[of]] that is currently assigned to said instant messenger matches the specific presence state associated with the received instant messaging operation, wherein said current presence state corresponds to said given user; and in response to determining that said specific presence state of the received instant messaging operation matches said current presence state assigned to said instant messenger, performing said instant messaging operation.

In previously rejecting claim 1, the Examiner refers to portions of Seshadri at columns 2, 4, 5, and 12 as disclosing the various claim features of receiving an instant messaging operation direct to a given user, where the operation is associated with a given presence state of an instant messenger; determining a current presence state of the instant messenger in response to receiving the instant messaging operation, and in response to determining that the given presence state matches the current presence state, processing the instant messaging operation. Office Action at 9. Applicants respectfully disagree and note that while Seshadri makes mention of aspects of an instant messenger, Seshadri fails to disclose the specific features that claim 1 requires.

In general, Seshadri is directed to an “information agent” that is capable of “routing communications in accordance with an expression and flexibility framework.” Seshadri at col. 2, lines 7-9. A primary focus of Seshadri is to determine what a user’s “context” is and to use such context information to process communications. *Id.* at cols.

11-15. For example, Seshadri describes one example of rule-based context processing as “Don’t interrupt with an Instant Message request while presenting (context of presenting inhibits instant message requests).” *Id.* at col. 4, lines 16-18.

Seshadri illustrates the relationship between context, rules, and actions in FIG. 7. As shown there and as discussed at cols. 10-11, context data 710 is an input to rules logic 714 and influences the ultimate processing action that is taken. Seshadri’s definition of context data includes numerous sources of hardware and software information. *Id.* at col. 12, lines 18-63. In particular, context information may be gathered from the fact that “[an] IM client is being used to send and receive [IM] messages” and from “user entered IM status.” *Id.* Thus, according to Seshadri, these aspects of an IM client may form part of the input context that is taken into account when deciding how to process a communication event.

However, claim 1 specifically requires that it is the instant messaging operation itself that is performed in response to determining a recited condition. This differs from Seshadri in at least two respects. First, to the extent that Seshadri specifically discusses rule-based context processing as applied to instant messaging operations, Seshadri discloses that an instant messaging operation should be suppressed rather than performed (“Don’t interrupt with an Instant Message request,” *id.* at col. 4, lines 16-18 (emphasis added)).

Second, Seshadri discloses an instant messaging operation only as part of the input context that governs the processing of some entity other than an instant messaging operation. That is, Seshadri fails to disclose that instant messaging operations themselves are processed as a consequence of the input context. Seshadri devotes considerable detail to describing how electronic mail may be processed using the described context model. *Id.* at cols. 15-17. Alternatively, Seshadri describes how the context model may be employed to perform telephone call routing. *Id.* at col. 17, lines 37-64. However, Seshadri specifically omits any mention of how an instant messaging operation may be

the object of processing itself, as opposed to merely an input to processing of something else.

Additionally, claim 1 requires that a specific presence state be associated with a received instant messaging operation, and that this specific presence state be determined separately from a current presence state that is currently assigned to an instant messenger. That is, claim 1 requires that the specific presence state associated with the received instant messaging operation and the current presence state of the instant messenger be distinct, separately determinable entities. At most, Seshadri's mention of "user entered IM status" describes the status that is associated with the instant messenger itself. Seshadri fails to disclose anything that could correspond to the separate presence state entity associated with the received instant messaging operation that is required by claim 1

Finally, claim 1 requires that the recited instant messaging operation be performed in response to determining that the specific presence state associated with the instant messaging operation matches the current presence state assigned to an instant messenger. Seshadri's vague mention of IM status as constituting part of a broad cloud of "context information" does not amount to a disclosure of the specific recitals of claim 1. Seshadri simply fails to mention any aspect of determining whether a current presence state assigned to an instant messenger matches a specific presence state associated with a received instant messaging operation, much less performing any action in response to making such a determination.

Seshadri also fails to disclose all of the features of amended independent claim 11. Claim 11 requires storing an instant messaging operation associated with a specific presence state of an instant messenger, wherein the specific presence state associated with the received instant messaging operation is determined separately from a current presence state that is currently assigned to the instant messenger. As noted above with respect to claim 1, Seshadri fails to disclose a specific presence state associated with a received instant messaging operation as a distinct entity from a current presence state of

an instant messenger. Seshadri further fails to mention any aspect of storing an instant messaging operation.

Claim 11 further requires detecting a transition of said current presence state assigned to said instant messenger to said specific presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting. No aspect of Seshadri suggests that a transition of a current presence state assigned to an instant messenger is ever detected. Moreover, as noted above, Seshadri does not disclose that instant messaging operations are performed in response to some condition, but instead discloses that such operations are inhibited.

Similar arguments apply to amended independent claims 20 and 39, which recite at least some features similar to amended independent claim 1, and to amended independent claims 30 and 49, which recite at least some features similar to amended independent claim 11.

Applicant notes that “unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it . . . cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIn, Inc. v. Verisign, Inc.*, Appeal 2007-1565, Slip Op. at 17-18 (Fed. Cir. October 20, 2008) (emphasis added). Applicant submits that Seshadri both fails to disclose all of the features recited in the independent claims as well as their recited arrangement. Therefore, Seshadri fails to anticipate these claims or their dependent claims.

Section 103(a) Rejection:

The Office Action rejected claims 4, 16, 23, 35, 42 and 54 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Seshadri in view of Cristofalo, et al. (U.S. Publication 2002/0152117), claims 5, 7, 8, 13, 15, 17, 24, 26, 27, 32, 34, 36, 43, 45, 46, 51, 53 and 55 as allegedly being unpatentable over Seshadri in view of Horvitz (U.S.

Publication 2002/0087649), claims 6, 25 and 44 as allegedly being unpatentable over Seshadri and Horvitz in view of Beyda (U.S. Publication 2003/0229722), and claims 9, 18, 28, 37, 47 and 56 as allegedly being unpatentable over Seshadri in view of Horvitz (U.S. Publication 2008/0104517). Applicant can find no language in the remaining cited references that remedies the omissions of Seshadri discussed above, and respectfully submit that these rejections would be unsupported as to the amended claims for at least the reasons given with respect to the independent claims.

In regard to all the rejections, Applicant submits that the rejections of various ones of the dependent claims are further unsupported by the cited references. However, as the rejections of the independent claims have been shown to be unsupported, further discussion of the dependent claims is unnecessary at this time.

CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-69900/RCK.

Respectfully submitted,

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